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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/068,377	05/08/1998	LAURENCE A. LASKY	P1066P2	2255

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EXAMINER	
RAWLINGS, STEPHEN L	
ART UNIT	**PAPER NUMBER**
1642	

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/068,377	LASKY ET AL.	
	Examiner	Art Unit	
	Stephen L. Rawlings, Ph.D.	1642	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): See attached Note of Explanation.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See attached Note of Explanation*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *16-18 and 24*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☒ Other: *See attached Note of Explanation*

Note of Explanation

1. The amendment filed September 3, 2004 is acknowledged and has been entered. Claim 24 has been amended.

2. The amendment filed September 3, 2004 fails to place this application in condition for allowance, since the amendment fails to obviate the following grounds of rejection:

(a) The rejection of claims 16, 17, and 24 under 35 USC § 102(b) as being anticipated by Sodhi et al. for the reason set forth in section 10 of the Office action mailed June 30, 2004; and

(b) The rejection of claims 16-18 and 24 under 35 USC § 102(b) as being anticipated by Frackelton et al. for the reason set forth in section 11 of the Office action mailed June 30, 2004.

3. The amendment filed September 3, 2004 has overcome the following grounds of rejection:

(a) The rejection of claims 16-18 and 24 under 35 USC § 112, first paragraph for the reason set forth in section 7 of the Office action mailed June 30, 2004;

(b) The rejection of claim 24 under 35 USC § 102(a) as being anticipated by Spencer et al., as evidenced by Becker et al., for the reason set forth in section 9 of the Office action mailed June 30, 2004;

(c) The rejection of claims 16-18 and 24 under 35 USC § 103(a) as being unpatentable over Spencer et al. in view of Ackerman and Nakamura et al. for the reason set forth in section 13 of the Office action mailed June 30, 2004; and

(d) The rejection of claim 24 under 35 USC § 103(a) as being unpatentable over Database SPTREMBL 23 Accession No. P978144 in view of Ackerman and Nakamura et al. for the reason set forth in section 14 of the Office action mailed June 30, 2004.

4. The amendment filed September 3, 2004 has resolved the issue of priority, which is set forth in section 5 of the Office action mailed June 30, 2004. The earliest effective filing date of the instant claims 16-18 and 24 is now considered February 7, 1997, since this application is the National Stage entry of PCT/US98/01774, filed January 30, 1998, which claims priority to US Application No. 08/938,830, filed September 29, 1997, which claims priority to US Provisional Application No. 60/104,589, filed February 7, 1997.

5. The request for reconsideration in view of Applicant's arguments traversing the maintained grounds of rejection under 35 USC § 102(b) has been carefully considered but Applicant's arguments have not been found persuasive for the following reasons:

Applicant's have argued that, because claims 16-18 and 24, as presently amended, require that the claimed antibody be "derivable from a lymphocyte from an animal that has been immunized with a PST phosphatase interacting protein (PSTPIP) polypeptide of SEQ ID NO: 1 or a fragment thereof", neither Sodhi et al. nor Frackelton et al. anticipate the claimed invention, since neither reference teaches that an antibody that binds the polypeptide of SEQ ID NO: 1 can be derived from an animal that has been immunized with the polypeptide or a fragment thereof. This argument is not persuasive because the anti-phosphotyrosine antibody taught by the prior art binds the polypeptide of SEQ ID NO: 1, as evidenced by the teachings of Spencer et al. (of record). Spencer et al. teaches an anti-phosphotyrosine antibody is capable of binding the polypeptide of SEQ ID NO: 1 (i.e., PSTPIP); see, e.g., page 847, column 2; and page 851, Figure 6.

Even though the anti-phosphotyrosine antibody of the prior art was not derived from a lymphocyte of an animal immunized with the polypeptide of SEQ ID NO: 1 or a fragment thereof per se, the patentability of a product does not depend on its method of production. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is

unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). See MPEP § 2113.

Nevertheless, it is noted that claim 24 is drawn to an antibody *derivable* from, i.e., having the capability of being derived from an animal immunized with the polypeptide of SEQ ID NO: 1 or a fragment thereof. As evidenced by Wang et al. (*Mol. Cell. Biol.* 1985 Dec; **5** (12): 3640--3643), and absent a showing otherwise, an anti-phosphotyrosine antibody could be derived from a lymphocyte from an animal that has been immunized with the polypeptide of SEQ ID NO: 1 or a fragment thereof containing the phosphotyrosine epitope to which the antibody binds, since Wang et al. teaches immunizing an animal with a tyrosine-phosphorylated protein elicited the production of anti-phosphotyrosine antibodies (see, e.g., the abstract).

Moreover, Glenney et al. (*J. Immunol. Methods.* 1988 May 9; **109** (2): 277-285) teaches an anti-phosphotyrosine antibody can be derived from a lymphocyte of an animal immunized with a phosphotyrosine coupled to a carrier protein, such as bovine serum albumin (BSA). As evidenced by Spencer et al. (of record), the polypeptide of SEQ ID NO: 1 (i.e., PSTPIP) contains phosphotyrosine. Accordingly, as evidenced by Glenney et al., absent a showing otherwise, an antibody capable of binding the polypeptide of SEQ ID NO: 1 can be derived from a lymphocyte of an animal immunized with a fragment of the polypeptide of SEQ ID NO: 1, namely a phosphotyrosine residue.

Furthermore, at page 3 (lines 3-5), for example, the specification teaches the present invention provides antibodies that are capable of binding to the polypeptide of SEQ ID NO: 1. Then, in Figure 6, and at page 37 (lines 15-21) and page 41 (lines 13 and 14), the specification discloses that an anti-phosphotyrosine antibody is capable of binding the polypeptide of SEQ ID NO: 1. Thus, an anti-phosphotyrosine antibody capable of binding the polypeptide of SEQ ID NO: 1 is encompassed by the present claims. Since the prior art teaches an anti-phosphotyrosine antibody, which is capable of binding the polypeptide of SEQ ID NO: 1, the disclosures of the prior art anticipate the claimed invention.

Products of identical chemical composition cannot have mutually exclusive properties. Moreover, a chemical composition and its properties are inseparable. If the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). See MPEP § 2112.01.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Rawlings, Ph.D. whose telephone number is (571) 272-0836. The examiner can normally be reached on Monday-Friday, 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on (571) 272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephen L. Rawlings, Ph.D.
Examiner
Art Unit 1642

slr
September 22, 2004

JEFFREY SIEW
SUPERVISORY PATENT EXAMINER
9/22/04